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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* FRANK ADDANTE
9

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11 Appeal 2008-4617
12 Application 09/851,029
13 Technology Center 1700
14

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16 Decided: January 28, 2009
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19 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.
20 FETTING, *Administrative Patent Judges*.

21
22 FETTING, *Administrative Patent Judge*.
23

24
25 DECISION ON APPEAL

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27 STATEMENT OF THE CASE

28 Frank Addante (Appellant) seeks review under 35 U.S.C. § 134 of a
29 Final Rejection of claims 1-88, the only claims pending in the application on
30 appeal.

31 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
32 (2002).

1 We AFFIRM-IN-PART.

2 The Appellant invented a way of digital advertising via computer
3 networks, for monitoring and recording transactions of a user who is
4 redirected to a transaction site after selecting an advertisement (Specification
5 1:14-18).

6 An understanding of the invention can be derived from a reading of
7 exemplary claim 1, which is reproduced below [bracketed matter and some
8 paragraphing added].

9 1. A computer network comprising:
10 [1] a user node to provide a request to perform a transaction and
11 a request to record the transaction;
12 [2] a transaction node to receive the request to perform the
13 transaction, to perform the transaction in response, and to
14 provide a transaction confirmation to the user node, the
15 transaction confirmation including a command to record the
16 transaction; and
17 [3] a monitor node to receive the request to record the
18 transaction provided by the user node in response to the
19 command to record the transaction, and to record the
20 transaction in response to the request to record the transaction.

22 This appeal arises from the Examiner's Final Rejection, mailed May
23 30, 2006. The Appellant filed an Appeal Brief in support of the appeal on
24 July 2, 2007. An Examiner's Answer to the Appeal Brief was mailed on
25 October 18, 2007. A Reply Brief was filed on December 14, 2007.

27 PRIOR ART

28 The Examiner relies upon the following prior art:

29	Davis	US 5,796,952	Aug. 18, 1998
30	Messer	WO 98/57285	Dec. 17, 1998
31	Angles	US 5,933,811	Aug. 3, 1999

REJECTIONS

Claims 1-12, 14, 16, 18-30, 33-52, 55-62, 64-78, 80-83, and 85-87 stand rejected under 35 U.S.C. § 102(b) as anticipated by Messer.

Claims 13, 15, 17, 31, 32, 53, 54, 63, 79, and 84 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles.

Claim 88 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Messer and Davis.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-12, 14, 16, 18-30, 33-52, 55-62, 64-78, 80-83, and 85-87 under 35 U.S.C. § 102(b) as anticipated by Messer.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 13, 15, 17, 31, 32, 53, 54, 63, 79, and 84 under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 88 under 35 U.S.C. § 103(a) as unpatentable over Messer and Davis.

The pertinent issue turns on whether Messer describes a user node that provides a request to record the transaction and a monitor node to record the transaction in response to the request to record the transaction.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Messer

01. Messer is directed to a referral tracking and control system for promoting goods and services on a wide area, public/private access network, such as the Internet (Messer 1:5-7).
02. Messer describes transactions that occur between a Site Owner server and Merchant server via a Clearinghouse server (Messer 7:6-25).
03. Messer's Clearinghouse server is programmed to communicate with the Merchants and Site Owner to facilitate the tracking and accounting associated with the successful Merchant based transactions (Messer 7:25-28).
04. In operation, when Messer's USER selects a banner ad, the site program inputs onto the USER command line the address for the Clearinghouse. Accordingly, USER access is directed to the Clearinghouse server, wherein the Clearinghouse server first stores several pieces of information, such as a site (ID), banner (ID), and USER (X). Immediately thereafter the Clearinghouse server places onto the USER command line, the address for the Merchant (HTTP) directing USER control to the Merchant's web page. Information about the product described in the banner ad is now displayed to the USER including the procedure for purchasing the product (Messer 13: 24-36).

1 05. Messer's USER has the option of purchasing the product
2 advertised in the banner ad. If the USER does not make a
3 purchase, a cookie is placed on the USER by the Merchant server.
4 This cookie is tracked by the Merchant server if a subsequent
5 purchase is made. If the USER makes the purchase, information
6 relating to the purchase and the USER are transferred back to the
7 Clearinghouse server. Sales particulars including all co-
8 promotion and commission payment are then calculated at the
9 Clearinghouse server. After information is received about the
10 purchase at the Clearinghouse server, a commission determination
11 is calculated. Once these terms have been implemented, final
12 accounting for the Merchant and Site Owner is implemented on
13 the Clearinghouse server, including payment of commission and
14 recording all transaction details. In this way, valuable records
15 detailing the activity of select banners in terms of revenue are
16 created on the Clearinghouse server (Messer 14:1-20).

17 *Angles*

18 06. Angles is directed to delivering customized advertisements
19 within interactive communications systems (Angeles 1:9-12).

20 *Davis*

21 07. Davis is directed to monitoring client use of and interaction
22 with a resource downloaded from a server on a computer network,
23 storing monitored data, creating a database including profiles
24 indexed by user and/or resource identity, and generating
25 customized resources based upon client profiles (Davis 1:8-13).

26 *Facts Related To The Level Of Skill In The Art*

1 08. Neither the Examiner nor the Appellant has addressed the level
2 of ordinary skill in the pertinent arts of systems analysis and
3 programming, ecommerce transaction systems, and we will
4 therefore consider the cited prior art as representative of the level
5 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
6 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings
7 on the level of skill in the art does not give rise to reversible error
8 ‘where the prior art itself reflects an appropriate level and a need
9 for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*
10 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

11 *Facts Related To Secondary Considerations*

12 09. There is no evidence on record of secondary considerations of
13 non-obviousness for our consideration.

14
15 PRINCIPLES OF LAW

16 *Claim Construction*

17 During examination of a patent application, pending claims are
18 given their broadest reasonable construction consistent with the
19 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
20 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

21 Limitations appearing in the specification but not recited in the claim
22 are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d
23 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
24 specification” without importing limitations from the specification into the
25 claims unnecessarily).

1 Although a patent applicant is entitled to be his or her own
2 lexicographer of patent claim terms, in *ex parte* prosecution it must be
3 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
4 must do so by placing such definitions in the specification with sufficient
5 clarity to provide a person of ordinary skill in the art with clear and precise
6 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
7 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the
8 specific terms used to describe the invention, this must be done with
9 reasonable clarity, deliberateness, and precision; where an inventor chooses
10 to give terms uncommon meanings, the inventor must set out any
11 uncommon definition in some manner within the patent disclosure so as to
12 give one of ordinary skill in the art notice of the change).

13 *Anticipation*

14 "A claim is anticipated only if each and every element as set forth in
15 the claim is found, either expressly or inherently described, in a single prior
16 art reference." *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631
17 (Fed. Cir. 1987). "When a claim covers several structures or compositions,
18 either generically or as alternatives, the claim is deemed anticipated if any of
19 the structures or compositions within the scope of the claim is known in the
20 prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The
21 identical invention must be shown in as complete detail as is contained in the
22 ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir.
23 1989). The elements must be arranged as required by the claim, but this is
24 not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In*
25 *re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

26 *Obviousness*

1 A claimed invention is unpatentable if the differences between it and
2 the prior art are “such that the subject matter as a whole would have been
3 obvious at the time the invention was made to a person having ordinary skill
4 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.
5 Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14
6 (1966).

7 In *Graham*, the Court held that the obviousness analysis is bottomed
8 on several basic factual inquiries: “[(1)] the scope and content of the prior art
9 are to be determined; [(2)] differences between the prior art and the claims at
10 issue are to be ascertained; and [(3)] the level of ordinary skill in the
11 pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 127 S. Ct. at 1734.
12 “The combination of familiar elements according to known methods is likely
13 to be obvious when it does no more than yield predictable results.” *Id.* at
14 1739.

15 “When a work is available in one field of endeavor, design incentives
16 and other market forces can prompt variations of it, either in the same field
17 or a different one. If a person of ordinary skill can implement a predictable
18 variation, § 103 likely bars its patentability.” *Id.* at 1740.

19 “For the same reason, if a technique has been used to improve one
20 device, and a person of ordinary skill in the art would recognize that it would
21 improve similar devices in the same way, using the technique is obvious
22 unless its actual application is beyond his or her skill.” *Id.*

23 “Under the correct analysis, any need or problem known in the field
24 of endeavor at the time of invention and addressed by the patent can provide
25 a reason for combining the elements in the manner claimed.” *Id.* at 1742.
26

ANALYSIS

Claims 1-12, 14, 16, 18-30, 33-52, 55-62, 64-78, 80-83, and 85-87 rejected under 35 U.S.C. § 102(b) as anticipated by Messer.

The Appellant argues these claims in two groups, viz., a group consisting of claims 1-12, 14, 16, 18-30, 33-52, 55-62, and 64-77 and a second group consisting of claims 78, 80-83, and 85-87. Accordingly, we select claims 1 and 78 as representative of the groups.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Messer anticipated claim 1 (Answer 3).

The Appellant contends that Messer does not describe a request from a user node to record the transaction, or a transaction confirmation including a command to record the transaction as required by the claims (Br. 5: First full ¶). The Appellant contends that when Messer's user makes a purchase, the merchant site can track the purchase, and a clearinghouse server can calculate various data (Br. 5: Second full ¶), but there is no suggestion that any information is recorded based on a specific request from a user node to record the transaction as required by the claims (Br. 9:Third ¶, beginning "However").

We disagree with the Appellant.

Initially we map Messer's structure to the claim. Messer's Site Owner server corresponds to the claimed user node. Messer's Merchant server corresponds to the claimed transaction node. Messer's Clearinghouse server corresponds to the claimed monitor node (FF 03).

Next we describe Messer's transaction flow. Messer's transaction begins when a user selects a banner ad, which passes a message to Messer's Clearinghouse server, which then passes a message to Messer's Merchant

1 server (FF 04). If a user purchases the product in a banner ad, a message
2 passes back to Messer's Clearinghouse server with purchase information,
3 where transaction details are recorded (FF 05). Thus, the Clearinghouse
4 server stores information only after the Site Owner server and Merchant
5 server both pass messages to the Clearinghouse server.

6 Messer's Site Owner, corresponding to the claimed user node, thus
7 provides a request to perform a transaction. The transaction requested is that
8 of the entire process flow described by Messer. Messer's Merchant server,
9 the transaction node, receives the request to perform the transaction,
10 performs the transaction in response, and provides a transaction
11 confirmation to the user node via the Clearinghouse server. This message
12 passed from the Merchant to the Clearinghouse includes a command to
13 record the transaction. Messer's Clearinghouse server, the monitor node,
14 receives the request to record the transaction and records the transaction.

15 The issues are then whether Messer's Site Owner server provides a
16 request to perform a transaction and a request to record a transaction;
17 whether Messer's Clearinghouse server receipt of the request to record the
18 transaction provided by the user node is in response to the command to
19 record the transaction; and whether Messer's Clearinghouse server records
20 the transaction in response to the request to record the transaction.

21 Clearly the selection of Messer's ad banner is a request to perform the
22 transaction that the ad banner is designed to promote. At the time of ad
23 banner selection, it is as yet unknown whether there will be a transaction to
24 record. But when a transaction is executed at the Merchant server, it is as a
25 result of the messages passed from the Site Owner and Clearinghouse
26 servers. Thus, when the Merchant site passes a message to the

1 Clearinghouse server to record a transaction, that message is the result of the
2 original selection of a banner ad from the Site Owner server.

3 Limitation [1] of claim 1 requires that this request to record a
4 transaction be provided by the user node. There is no further limitation on
5 the mechanism of such provision. Limitation [1] does not require, in
6 particular, that the message that ultimately contains the request be itself
7 generated by the user node. It is sufficient for the act of providing that the
8 message causally result from some structure of or activity by the user node.
9 Because the message to record the transaction results from the selection of
10 the banner ad leading to the purchase, this message is provided by the
11 actions on the user node and therefore is provided by the user node.

12 Alternatively, a message to record the transaction is implicitly
13 contained within the transaction requesting the transaction by operation of
14 Messer's process flow. The fact the message to record as a separate entity is
15 instantiated on a different server does not negate the original implicit
16 message to record within the message to perform at the time of the ad
17 selection by virtue of the operation of Messer's system.

18 As to the second issue, Messer's Clearinghouse server's receipt of the
19 request to record the transaction is in response to the messages from the Site
20 Owner server to Clearinghouse server, Clearinghouse server to Merchant
21 server, and Merchant server back to Clearinghouse server, and is thus in
22 response to the command to record the transaction provided by the banner ad
23 selection as discussed *supra*.

24 As to the third issue, Messer's Clearinghouse server receives the
25 transaction in response to the command now coming from the Merchant
26 server to record the transaction, and records the transaction. This

1 recordation is in response to the original triggering of the transaction, viz.,
2 selection of the ad banner, because the entire process flow is in response to
3 that trigger.

4 The Appellant has not sustained its burden of showing that the
5 Examiner erred in rejecting claims 1-12, 14, 16, 18-30, 33-52, 55-62, and
6 64-77 under 35 U.S.C. § 102(b) as anticipated by Messer.

7 As to independent claim 78, this claim requires formatting a cookie at
8 an ad server; storing a cookie at a user node of a user who made the
9 selection; and providing the cookie from the user node to the ad server
10 whenever the user makes a transaction at a sale site associated with the
11 advertisement. The Examiner found that Messer anticipated claim 78
12 (Answer 12-13). The Appellant argues that Messer does not refer to an ad
13 server and that the only server that formats a cookie in Messer, the Merchant
14 server, is not an ad server.

15 We agree with the Appellant. The Examiner cites Messer 13:24-14:8
16 for support. The Examiner further construed Messer's content site to be an
17 ad server and found that the cookie was edited at several sites. We find that
18 the only description of editing a cookie at a specified server in Messer
19 occurs at the Merchant server (FF 05). The Examiner cites no specific
20 portion of Messer to support the finding that a cookie is edited at several
21 sites, and the portion the Examiner cited for general support refers only to
22 operations on the Merchant server. We find no portion of Messer to
23 describe editing at other than the Merchant server. An ad server is simply a
24 server for the administration of advertising. In Messer, this is performed by
25 its Clearinghouse server (FF 04 & 05). There is nothing in Messer that
26 suggests its Merchant server is an ad server.

The Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 78, 80-83, and 85-87 under 35 U.S.C. § 102(b) as anticipated by Messer.

Claims 13, 15, 17, 31, 32, 53, 54, 63, 79, and 84 rejected under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles.

The Appellant relies on the arguments in support of claim 1, which we found unpersuasive *supra*, and claim 78, which we found persuasive. The Appellant has therefore not sustained its burden of showing that the Examiner erred in rejecting claims 13, 15, 17, 31, 32, 53, 54, and 63, but has sustained its burden of showing that the Examiner erred in rejecting claims 79 and 84, under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles.

Claim 88 rejected under 35 U.S.C. § 103(a) as unpatentable over Messer and Davis.

The Appellant relies on the arguments in support of claim 78, which we found persuasive *supra*. The Appellant has therefore sustained its burden of showing that the Examiner erred in rejecting claim 88 under 35 U.S.C. § 103(a) as unpatentable over Messer and Davis.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-12, 14, 16, 18-30, 33-52, 55-62, and 64-77 under 35 U.S.C. § 102(b) as anticipated by Messer. The Appellant has sustained its burden of showing that the Examiner erred in rejecting

claims 78, 80-83, and 85-87 under 35 U.S.C. § 102(b) as anticipated by
Messer.

The Appellant has not sustained its burden of showing that the
Examiner erred in rejecting claims 13, 15, 17, 31, 32, 53, 54, and 63 under
35 U.S.C. § 103(a) as unpatentable over the prior art. The Appellant has
sustained its burden of showing that the Examiner erred in rejecting claims
79, 84, and 88 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-12, 14, 16, 18-30, 33-52, 55-62, and 64-77 under 35 U.S.C. § 102(b) as anticipated by Messer is sustained.
- The rejection of claims 78, 80-83, and 85-87 under 35 U.S.C. § 102(b) as anticipated by Messer is not sustained.
- The rejection of claims 13, 15, 17, 31, 32, 53, 54, and 63 under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles is sustained.
- The rejection of claims 79 and 84 under 35 U.S.C. § 103(a) as unpatentable over Messer and Angles is not sustained.
- The rejection of claim 88 under 35 U.S.C. § 103(a) as unpatentable over Messer and Davis is not sustained.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2008-4617
Application 09/851,029

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